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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,836	01/07/2002	Marshall O. Townsend II	GLFP-1-1001	4549

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EXAMINER

LEGESSE, NINI F

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

88

Office Action Summary	Application No. 10/041,836	Applicant(s) TOWNSEND, MARSHALL O.	
	Examiner Nini F. Legesse	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 29-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 and 29-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's response to the office action of 11/21/05 is acknowledged on 03/23/06.

Specification

The amendment filed 03/23/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: the expression "a unique lateral component.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

Applicant has provided two claims as claim 43. For purpose of examination, the last claim is considered as claim 44.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12 and 29-44 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The expression "a unique lateral component" in claims 12 and 29 raise new matter issue.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 12 and 29-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 12 and 29 the expression "a unique lateral component" is not clear. It is not clear what Applicant is considering unique lateral component.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 29-34, 36, 37, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baxstrom (US Patent No. 4,915,387) in view of Strande (US Patent No. 6,949,029).

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Baxstrom teaches a template (22) having a top and bottom and a graphic design (see figures 1-3) attached to the template. The graphic design depicting a "plurality of club path indicators" (34), a "swing reference guide" (RF, FR2A, RF2B, LF, LF2; see column 4, lines 1+), and a "link" (see column 4, lines 59-64 and column 7, lines 4-12).

Regarding the swing reference guide, in as much set forth by applicant in the claim, this guide clearly establishes "shot" selection types. Club selection is synonymous with "shot selection." For example, if a low loft shot is needed, a low number iron is used, such as a 3 iron. If a high loft shot is need, a high number iron is used, such as a 9 iron. In the alternative, see elements 30 and/or 32 that may also be considered a "swing reference guide" which define a plurality of shot selection types. For a regular loft shot, a golfer would place the golf ball relative to element 30. For a lower loft shot, the golfer would place the golf ball relative to element 32 (see column 4, lines 31+; see also column 7, lines 50-52). It can be argued that Baxstrom does not disclose the specific arrangement and/or content of indicia (printed matter) set forth in the claim. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the markings as claimed since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of instruction does not alter the functional relationship. Mere support by the

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substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter e.g. reference guide and the substrate e.g. template/mat that is required for patentability. Reference characters 34 clearly denote a "primary" club path. Element 30 is a club face angle indicator (see column 7, lines 17+). In as much structure set forth by applicant in claim 36, any of the corners of the template may be grabbed to allow an individual to move/carry the template, thereby inherently defining a "handle." It is clear that Baxstrom fails to disclose a tee bore extending through the template and a tee slot. However Strande teaches the use of a tee bore and a tee slot on a golf-training device (see element 64 on Fig. 1). It would have been obvious to one of ordinary skill in the art to provide the Baxstrom device with a slot as taught by Strande in order to simplify the manufacturing process of the device.

In addition, each of the above claims is rejected with Baxstrom in view of Gibbs et al.

(US Patent No. 1,484,390) and Strande (US Patent No. 6,949,029).

Gibbs discloses an instruction chart for playing golf comprising: a template (see Fig. 2), the template having a top and a bottom, a graphic design attached to the template, the graphic design depicting a swing reference guide comprising a plurality of shot selection types (here a "brassie" shot, see Fig. 1 for a drive, Fig. 3 for a "mid-iron" etc); a link between each one of the plurality of shot selection types and one of the club path indicators (11, all the instructions that are shown on the template could be considered as links); and a foot (for example 2 and 3) and ball position indicator (7). It is obvious to

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employ Gibbs to provide further instructions of performing a specific shot. In so doing, the instructions would be coded as is already suggested in the Baxstrom reference. It is clear that Baxstrom fails to disclose a tee bore extending through the template and a tee slot. However Strande teaches the use of a tee bore and a tee slot on a golf-training device (see element 64 on Fig. 1). It would have been obvious to one of ordinary skill in the art to provide the Baxstrom device with a slot as taught by Strande in order to simplify the manufacturing process of the device.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 12 above, and further in view of Long (Us Patent No. 5,273,285).

Baxstrom fails to disclose the use of an ultraviolet protective layer in his device. On the other hand, Long discloses the use of an ultraviolet protective layer in his device (see column 3 lines 65-68). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the Baxstrom device with an ultraviolet protective layer as taught by Long in order to prolong the life of the device by protecting it from sun damage.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 12 above, and further in view of Florian (US Patent No. 6,156,396).

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Baxstrom fails to disclose a laminated template. On the other hand, Florian teaches a laminated golf practice mat (see column 2 lines 1-3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to laminate the Baxstrom device as taught by Florian in order to provide an anti-friction layer that is durable.

Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 12 and 29 above, and further in view of Molinar (US Patent No. 2,652,251).

The references as applied to the independent claims do not explicitly state pen, square, and closed clubface marker. However Molinar is one reference that teaches these types of markings (see Fig/ 1). Thus, it would have been obvious to one of ordinary skill in the art to combine the Molinar teaching to the Baxstrom device for guiding a golf player in an intended hook or slice as stated in column 1 lines 20-22 of the Molinar reference.

Response to Arguments

Applicant's arguments filed 03/23/06 have been fully considered but they are not persuasive.

On page 7 of Applicant's remark it is stated that none of the cited references alone or in combination teach or suggest the claimed limitations. This is respectfully disagreed because as disclosed above on the claim rejections, the references as combined clearly suggest the claimed invention.

On page 8 of Applicant's argument, Applicant discloses that the club path indicators are functionally related to the tee aperture and tee bore as guides for a club head striking a ball positioned over the tee bore. It is noted that these features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

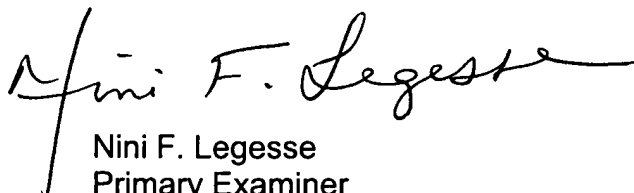
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (571) 272-4412. The examiner can normally be reached on 9 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Nini F. Legesse". The signature is fluid and cursive, with a long horizontal stroke at the end.

Nini F. Legesse
Primary Examiner
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05/22/06